

REMARKS

Petition to Revive

5 This amendment is being submitted in conjunction with a petition to revive an unintentionally abandoned patent application. Since this application was filed after June 8, 1995, no terminal disclaimer is required. Applicants respectfully request entry of this amendment prior to examination. Claims 1-27 and 51-77 are pending after revival.

10 **Fees**

Applicant has enclosed a check in the amount of \$1,000.00 for payment of the petition fees and any other additional fees. In the event additional fees are not required, please credit any over payment to deposit account 50-0913. However, if additional fees in excess of the \$1,000.00 payment enclosed are required, the Commissioner is ***not authorized*** to charge any additional fees 15 to deposit account 50-0913. Please Contact the Applicant's attorney if any additional fees are required.

Claim Rejections - 35 U.S.C. 102

The Office has rejected claims 1, 2, 13, 14, 16, 18-20, 51, 54, 62, 63, 65, 67, 69, and 75-20 77 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,612,575 to Cole et al. (hereinafter "Cole") or, in the alternative, under 35 U.S.C. 103(a) as being obvious over Cole et al. Applicant respectfully traverses this rejection.

The office action on page 2 describes the claims as being rejected under 35 U.S.C. 102(e) and 103(a). However, it is unclear as to which claims are being rejected under section 102 and which are being rejected under section 103.

On page 5, the office action states that it would have been obvious to one of ordinary skill

5 to calculate the odds for various game parameters and storing them in a game controller including odds of winning a primary game of chance, odds of obtaining a bonus game qualifying event in the primary wagering game, odds of winning the plurality of bonus prizes including the incrementing jackpot being dependent on the odds of winning the primary wagering game and of obtaining the bonus game qualifying event. However, no references are cited that show such a

10 series of calculations and storing them to a game controller.

Since, no references are cited, it appears that the examiner is relying on personal knowledge in this instance. The examiner is respectfully requested to provide an affidavit in support of each and every obviousness statement made in the office action as required under 37 CFR 1.104(d)(2).

15 Applicants respectfully request the Office to withdraw the §102 and 103 rejection.

Claim Rejection – 35 U.S.C. 103

The Office has rejected claims 3, 12, 22, 24-27, 55, and 66 under 35 U.S.C. 103(a) as being unpatentable over Cole.

20 On page 6 and 7, the office action states that Cole lacks a lighted display, a plurality of boxes and an animated character racing device. The office action further states that including these in Cole would be obvious.

On page 7, the office action states that Cole fails to disclose that a player must make a side wager to play the bonus game. The office action states that this is obvious in view of Cole.

However, no references are cited that show any of these elements. Since, no references are cited, it appears that the examiner is relying on personal knowledge in this instance. The examiner is respectfully requested to provide an affidavit in support of each and every obviousness statement made in the office action as required under 37 CFR 1.104(d)(2).

5 The Office has also rejected claims 4-11, 21, 23, 52, 53, 56-61, 64, 71, and 72 under 35 U.S.C. 103(a) as being unpatentable over Cole in view of U.S. Patent No. 5,280,909 to Tracy.

Tracey discloses a gaming system with progressive jackpot.

In order to establish prima facia obviousness, the Examiner must provide a clear explanation why one of ordinary skill in the art at the time the invention was made would have 10 been motivated to make the proposed modification (see MPEP 706.02(j)).

Applicant respectfully submits that there is no motivation or suggestion in Cole to modify Cole to include a maximum jackpot or to include a range around a fixed jackpot amount or to include a common jackpot display and that the claims are patentably distinguishable over the art of record.

15 Particularly, it is noted that neither Cole nor Tracy recognized the problem that Applicant's invention addresses and solves. The present invention is able to provide a randomly incrementing jackpot that is capable of providing a much more attractive and entertaining display than prior art devices. This results in longer playing times by players and increased gaming revenues for the game operator. Had Cole (instead of Applicant) recognized this problem, he 20 would have disclosed a device that operates in the claimed manner.

The Office also rejected claims 15 and 17 under 35 U.S.C. 103(a) as being unpatentable over Cole in view of U.S. Patent Number 5,911,626 to McCrae.

McCrae discloses a jackpot system for live card games based upon game play wagering and method therefore.

As the court of Appeals for the Federal Circuit has set forth, even if a prior art reference could be modified to construct an applicant's invention, the modification is not obvious unless there is a suggestion in the prior art. *In re Laskowski*, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989). There is no suggestion to modify Cole to include a live card game with a human dealer. Since Cole only discloses a slot machine, the only way to arrive at the proposed combination is in view of the Applicant's specification using impermissible hindsight reasoning.

The Office also rejected claim 68 under 35 U.S.C. 103(a) as being unpatentable over Cole in view of U.S. Patent Number 4,775,151 to Berry.

Berry discloses an apparatus for controlling and simulating the game of football. Berry does not disclose a device for manually stopping an incrementing jackpot. There is no disclosure, teaching or suggestion in either Berry or Cole of using an input device to manually stop an incrementing jackpot.

Such a combination can only be gleaned through hindsight reasoning. It has long been held that one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to depreciate the claimed invention. *In re Fine*, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

Finally, the Office rejected claims 70, 73, and 74 under 35 U.S.C. 103(a) as being unpatentable over Cole in view of U.S. Patent Number 5,911,418 to Adams.

Adams discloses a method of playing card games with an additional payout indicator.

In order to establish *prima facia* obviousness, the Examiner must provide a clear explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification (see MPEP 706.02(j)).

Applicant respectfully submits that there is no motivation or suggestion in Cole to modify Cole to include a gaming table and a rotating segmented prize wheel and that the claims are patentably distinguishable over the art of record.

Because the cited references do not teach, disclose or suggest all limitations of

5 Applicant's claims, Applicants respectfully request the Office to withdraw the §103(a) rejection.

Declaration under 37 C.F.R. 1.131

The Office has stated that the evidence submitted with the declaration of October 1, 2004 is insufficient to establish conception of the invention prior to the effective date of the Cole
10 reference.

Applicants respectfully disagree with this conclusion.

37 C.F.R. 1.131(b) states as follows:

(b) *The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained.*

20 Applicant has previously provided exhibit A, which is a copy of applicant's original invention disclosure and stated that the disclosure was conceived prior to September 1, 2000. As required under section 1.131(b), applicant has provided photocopies of original records of the invention.

25 Applicant has also previously provided a Declaration signed by the applicant proving conception of the invention disclosed and claimed in the instant patent application took place prior to the effective filing date of Cole. As a reference under 35 U.S.C. 102(e), the effective

date of Cole is its filing date; September 1, 2000. The Applicant's declaration establishes that his invention was conceived prior to September 1, 2000.

Applicant has also previously declared that prior to September 1, 2000 (the filing date of Cole) and until June 6, 2001 (the filing date of the present application) he continuously and
5 diligently performed or caused others to perform certain actions. These actions are evidence of facts showing diligence in the reduction to practice of the invention.

In further support of the reduction of the present invention to practice by Applicants, the enclosed additional factual evidence labeled as exhibits F, G and H are submitted. Exhibits F, G and H are true redacted¹ copies of invoices to Madness Gaming Products, the previous owner of
10 the present patent application from Ian F. Burns & Associates, P.C.

Exhibit F

Exhibit F shows that on October 14, 2000, the invention disclosure for the present invention was reviewed and claims were drafted by the Applicant's patent attorney. On October 15, 2000, claims were drafted, and the drawings and specification were prepared. On October 26, 2000, the patent application was sent from the patent attorney to the inventors for review. On November 14, 2000, the patent application was reviewed and revised in view of the inventor's comments and changes by the patent attorney. On December 8, 2000, the inventors met with their patent attorney to review and discuss the present patent application.

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Exhibit G

Exhibit G is evidence that on February 27 and 28 of 2001, the present patent application invention was reviewed and revised by the Applicant's patent attorney. Exhibit G also states that

on March 2, 2001 that a draft of the patent application was sent from the patent attorney to the inventors for review.

Exhibit H

5 Exhibit H shows that on April 10 and 13 of 2001, the present patent application was proofread and revised and the filing documents were prepared. On April 25, 2001, the declaration was prepared and sent to the inventors. The application was also prepared for filing on this day. On April 30, 2001, the patent application was reviewed and revised. The patent application was filed with the patent office on June 6, 2001.

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Conclusion

The additional evidence included with this petition is a clear showing of facts that establish the inventors due diligence and reduction to practice of the present invention.

15 Applicant has antedated the effective date of Cole by prior conception of the present invention prior to the effective date of the reference patent coupled with diligence in the reduction to practice of the invention. Therefore, Cole is not prior art to the present application.

Applicant respectfully requests acceptance of the declaration under 37 C.F.R. 1.131, withdrawal of the cited reference to Cole and withdrawal of all rejections.

20 For all of the above reasons, the Applicant submits that the present application is in condition for allowance. If the Examiner has any questions regarding the application or this

¹ Non-relevant information has been removed from the documents.

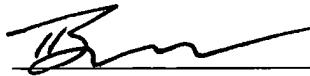
In re application of: Bradley W. Johnson

Serial Number: 09/876,546

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response, the Examiner is encouraged to call the Applicant's attorney, Ian F. Burns, at (775) 826-6160.

Respectfully submitted,



Ian F. Burns

Registration Number: 33,297

Attorney for Applicant

5 February 9, 2006